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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,668	12/18/2001	Stephen Griffin	1001.1535101	6574
28075 7590 01/09/2008 CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/025,668

Applicant(s)

GRIFFIN ET AL.

Examiner

Jonathan ML Foreman

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-16,20,24-41,44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-16,20,24-41,44 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 12/3/07 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 - 5, 20 - 24 and 36 - 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,944,701 to Dubrul in view of U.S. Patent No. 5,762,630 to Bley et al.

In regard to claims 1 - 5, 20 - 24 and 36 - 45, Dubrul discloses an elongate core wire comprising a nickel titanium alloy (Col. 2, line 4) and having a tapered distal portion (Col. 3, line 15 - 17); and a polymer jacket attached to and surrounding a portion of the core wire such that a majority of the length of the jacket in contact with the outer surface of the core wire, the jacket being more stiff than the portion of the core wire which it surrounds (Col. 3, lines 37 - 39). The core wire surrounded by the jacket is bent into a curved shape, wherein the polymer jacket overcomes biasing forces imposed by the core wire which tend to straighten the core wire from the curved shape such that stiffness of the jacket retains the core wire in the curved shape (Col. 3, lines

37 – 39). Dubrul discloses that near a patient's body temperature the core wire overcomes the stiffness provided by the polymer jacket (Col. 39 – 44). Dubrul discloses the use of shape memory polymers with the invention (Col. 3, lines 45 – 49) but fails to disclose the polymer jacket being a shape memory polymer characterized by a responsiveness to heating at or above a glass transition temperature to transform the shape memory polymer between a first shape and a second shape. Bley et al. teach a shape memory polymer which comprises polyurethane (Col. 4, lines 43 – 45) for use in a medical instrument inserted into a patient's body that is responsive to heating at or above a glass transition temperature to transform the shape memory polymer between a first shape and a second shape. Bley et al. teach the glass transition temperature to be near that of a patient's body temperature so that the device can assume a soften state once inserted (Col. 2, lines 27 – 35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the polymer jacket as taught by Dubrul to be a shape memory polymer as taught by Bley et al. in order to ensure that when inserted into the body the polymeric jacket takes a soften configuration that would allow the core wire to obtain a straightened configuration.

4. Claims 6 – 16 and 25 - 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,944,701 to Dubrul in view of U.S. Patent No. 5,762,630 to Bley et al. as applied to claims 1 and 20 above, and further in view of U.S. Patent No. 6,485,458 to Takahashi.

In reference to claims 6 – 16 and 25 - 35, Dubrul in view of Bley et al. disclose a shape memory polymer surrounding a portion of the core wire polyurethane, but fails to disclose the polymer being polcaprolactone, polymethylmethacrylate, PLLA, PLLA OGA, PL/D LA, PMMA, polyethylene, polyisoprene, styrene-butadiene or photocrosslinkable polymer. However, Takahashi discloses a shape memory polymer surrounding a core wire wherein the polymer consists of poluorbornen, styrene-butadiene, polyisoprene, polyester, polyolefin, acrylic and styrene-acrylic (Col.

5, lines 56 – 67). Takahashi teaches that other shape-memory materials can be used in addition to those disclosed. It would have been obvious to one having ordinary skill in the art at the time the invention was made use any shape memory polymer as taught by Takahashi in the device as disclosed by Dubrul in view of Bley et al. in that Takahashi teaches that shape memory polymers are interchangeable. Additionally, the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). In the present case, replacing the shape memory polymer as disclosed by Dubrul in view of Bley et al. with any other shape memory polymer is a design consideration within the skill of the art.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JMLF

